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23879	7590	02/07/2006	EXAMINER	
BRIAN M BERLINER, ESQ O'MELVENY & MYERS, LLP 400 SOUTH HOPE STREET LOS ANGELES, CA 90071-2899			ROWAN, KURT C	
			ART UNIT	PAPER NUMBER
			3643	

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Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 18-23, 26-30, 36-40, 42-43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,327,812. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same method steps are recited such as positioning a plurality of temperature probes, providing at least one ingress duct, heating an environmentally acceptable gas, directing the heated gas into the enclosure, monitoring the temperature of the probes, recording the temperatures establishing at least a slight positive pressure within the enclosure and venting the heated gas from the enclosure.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 18-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation that the removal of the organisms by filtering to remove "microscopic particles" is new matter since the organisms stated to be removed were never referred to as "microscopic particles" in the specification as originally filed. Also, the scope of what constitutes a microscopic particle has never been defined.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 18-23, 26-30, 36, 40, 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forbes '329 in view of Montellano for substantially the same reasons stated in the last Office Action.

The patents to Forbes and Montellano show insect destroying methods and have been discussed in the first Office Action. In reference to claims 18, 20, and 26, Forbes shows all of the method steps recited such as providing an ingress duct 51, heating a gas by

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burner 25 to a temperature lethal to a predetermined species as disclosed by Forbes in column 4, lines 22-63. Forbes shows directing the heated gas into the enclosure in Fig. 1 using ingress duct 41. Forbes show extracting heated gas in column 4, lines 8-12. Forbes does not disclose extracting heat killed organisms which is shown by Montellano who discloses a filter made from metallic cloth. What constitutes metallic cloth will be discussed below. Hence, it would have been obvious to provide Forbes with an extraction step as shown by Montellano who vents and filters the outflow for the purpose of removing dead organisms. In reference to claim 36, Forbes discloses venting through a ventilation duct in column 3, lines 16-17. In reference to claim 37, it would have been obvious to provide the method of Forbes as modified by Montellano with a filter 3 as disclosed by Montellano to trap organisms killed during the operation of the method recited. In reference to claim 38, it would have been obvious to return filtered air to the interior since Forbes discloses recirculating air in column 2, lines 50-53. In reference to claim 39, Montellano discloses using suction to pull air from an enclosure and it follows that the filter be placed before the suction to ensure proper operation as shown by Montellano in Fig. 1.

In reference to claim 40, Forbes discloses heating outside the enclosed structure in Figure 1 noting burner 25. In reference to claim 42, Forbes shows directing heated gas into the interior portion using a duct 51. In reference to claim 43, Forbes discloses heating for about one hour in column 4, line 54.

Response to Amendment

7. The declarations under 37 CFR 1.132 filed Feb. 22, 2005 to Geyer (with exhibit A by Abbot) and to Linford are insufficient to overcome the rejection of claims 18-23, 26-30, 36-40, and 42-43 based upon Forbes in view of Montellano as set forth in the last Office action because: showing is not commensurate in scope with the claims, fails to set forth facts, and states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. If others were not working on the problem, then there was no long standing problem in the art. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04. Claim 18 does not recite that the organisms are micro-organisms and that the filter used to remove them is a HEPA filter as detailed in paragraphs 7 and 14 of the declaration to Geyer. In fact some of the subject matter that both declarations discuss, like the microorganisms from mold, have been deleted from the claims such as claims 23 and 30. Also, it is not clear if the heat tolerant HEPA filter air scrubber recited in paragraph numbered 7 of Geyer is the one used in the present invention. Also, the declarations talk about filtering in conjunction with recirculating the heated air as in paragraph numbered 8 in the Linford declaration. However, this feature is not recited in claim 18 or other independent claims for that matter. The declarations particularly Linford, in paragraphs numbered 11-12, fails to set forth facts and merely gives an opinion that the prior art reference to Montellano is merely a curiosity and even

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if considered, would be ineffective in removing the smaller allergens that are produced during the forced-convection of thermal eradication. Since Montellano discloses metallic cloth, the mesh size must be on the order of that of cloth if the strands are the same size or the spacing between the strands must be like that of cloth. So from a typical viewing distance the metallic cloth would look like cloth. Since the spacing of a screen and a sieve is much larger than that of cloth and these devices do not look like cloth, metallic cloth would have many more strands to the inch. As the number of strands per inch increases, the smaller the particle that could be caught by the material increases.

8. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Response to Arguments

9. Applicant's arguments filed Oct. 17, 2005 have been fully considered but they are not persuasive. Applicant's response overcomes the objection to the specification and the rejection under 35 USC 112, second paragraph. The examiner will maintain the double patenting rejection at this time but reserves the right to withdraw this grounds of rejection in the future. Applicant argues that the filter disclosed by Montellano would not function to remove microscopic particles since Montellano is concerned with extraction of macroscopic flying insects. However, as stated by Montellano in column 2, lines 62-64, discloses not only insects, but collecting dust as well. Clearly if Montellano can collect dust, then other microscopic material such as fungi and bacteria can also be collected. Hence, Forbes can kill not only insects such as termites, fleas but also microorganisms such as bacteria and fungi due the temperatures recited from 120

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degrees F to 160 degrees F is in the same range as recited in the present invention from 120 degrees F to 300 degrees F. Hence, the combination of Forbes in view of Montellano provides for the destruction and filter collection of insects and other microscopic particles making up bacteria and fungi as recited in the claims of the present invention. Also, Montellano discloses forced venting and filtration. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there is motivation in the references themselves to modify Forbes in the claimed manner. As to the declaration of Dr. Linford in paragraph 11 that Montellano has not been used in modern times is an opinion. Also, in regard to paragraph 12, that the filter of Montellano would not be effective in removing the smaller allergens that are produced during a forced convention thermal eradication can not be considered as a fact since no evidence or test results have been submitted comparing the metallic cloth filter of Montellano and a filter of the present invention. As to the unexpected results of the present invention, as applicant noted these results are compared to an unfiltered method not the method by the combination of Forbes and Montellano. As to commercial success, the examiner will reserve judgment until evidence of commercial success is submitted.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Rowan whose telephone number is (571) 272-6893. The examiner can normally be reached on Monday-Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Kurt Rowan", with a large checkmark-like flourish at the end.

Kurt Rowan
Primary Examiner
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KR